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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,149	01/06/2006	Bryan Barker Speight	6501-1049	2390
<div>466                      7590                      03/12/2009</div> <div>YOUNG &amp; THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314</div>				
EXAMINER				
OSTRUP, CLINTON T				
ART UNIT		PAPER NUMBER		
3771				
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03/12/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/535,149

**Applicant(s)**

SPEIGHT, BRYAN BARKER

**Examiner**

CLINTON OSTRUP

**Art Unit**

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action is in response to the amendment filed 11/26/08. As directed by the amendment, claim 1 has been amended, claims 2-5 have been cancelled, and claims 6-8 have been added. Thus, claims 1 and 6-8 have are pending in this application.

***New Matter Objection***

2. The amendment filed 11/26/08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The drawings show a specifically sized and shaped housing with a permanent magnet located in the housing and with a specific size and shape. These sizes, shapes and orientation of the objects were not disclosed in the application as originally filed.

3. The amendment also includes the added material on page 2, Brief Description of the Drawings which is not supported by the original disclosure. Moreover, the specification expands the strength of the magnet field from "preferably but not limited to the order of 1,500 gauss to 3,000 gauss" to "a permanent magnet of strength above 1500 gauss."

Applicant is required to cancel the new matter in the reply to this Office Action.

***Specification***

4. The use of the trademark TERAHALER™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Thus, the symbol "™" or the symbol "®" should follow the trademark name.

***Claim Rejections - 35 USC § 112, First Paragraph***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 6-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 6 and 8 expands the strength of the magnet field from "preferably but not limited to the order of 1,500 gauss to 3,000 gauss" to "a permanent magnet having a magnetic field above 1500 gauss" in claim 1 and "a permanent magnetic field of at least 1500 gauss" in claim 6.

Claims 7 and 8 are rejected as depending from a rejected base claim.

***Claim Rejections - 35 USC § 112, Second Paragraph***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claims 1, 6 and 8 are indefinite because they do not claim an upper magnetic field strength. It is highly unlikely that any and all electromagnetic field strengths can be used in the device as claimed. Therefore the meets and bounds of claims 1, 6 and 8 are unclear. Moreover, applicant has not provided a detailed explanation as to what size of magnet is used, what type of magnet is used (e.g. iron magnet, a neodymium-iron-boron magnet, or an electromagnet) and how they have obtained a magnetic field strength of above/at least 1,500 gauss.
10. Claim 7 is rejected as depending from a rejected base claim.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Wakuta (JP 59-36588).

Wakuta discloses a tubular device (4) that can be used as an inhaler device including an inlet (left side of tube) for air, a mouthpiece (right side of tube) for

connection to the breathing system of a human, and a permanent magnet (5) having magnetic field above 1500 gauss (2000-7000 Gauss) between the inlet and the mouthpiece, the permanent magnet being located in a stream of inhaled air that passes through the inhaler device. See: figure 2.

Regarding claim 6, Wakuta discloses a tubular device that can be used as an inhaler device comprising: a body (4) having at least a first (left side of tube) and a second opening (right side of tube), the first opening is an inlet that can be used for air intake, the second opening can be used as a mouthpiece for connecting to the breathing system of a human, and the permanent magnet (5) having magnetic field of at least 1500 gauss (2000-7000 Gauss) and positioned inside the body (figure 2) between the inlet and the mouthpiece, wherein the inlet, the permanent magnet, and the mouthpiece are arranged so that a stream of air from the inlet travels through the inhaler device, past the magnet, to the mouthpiece, and the magnetic field induces (the magnetic field disclosed by Wakuta meets the magnetic field claimed, thus it would inherently have the same resulting effects on oxygen) paramagnetism to oxygen in said stream of air.

Regarding claim 7, the permanent magnet disclosed by Wakuta is (2000-7000 Gauss) which encompasses the claimed magnetic field that is not more than 3000 gauss (i.e. 2000-2999 Gauss).

Regarding claim 8, the tubular device disclosed by Wakuta has the mouthpiece (right side of tube) that is arranged together with the inlet (left side of tube) that allows a user to draw air through the inhaler device.

Applicant is reminded that if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See: In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1 and 6-8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Souder (5,817,000) which discloses a box shaped device having two openings (one in front and one in back which can be considered an inlet and another in the back) and a magnetic field created by permanent magnets at a strength of 500-2000 Gauss.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLINTON OSTRUP whose telephone number is (571)272-5559. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Clinton Ostrup/  
Examiner, Art Unit 3771

/Justine R Yu/  
Supervisory Patent Examiner, Art Unit 3771